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HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

AHUJA, SUPRIYA

| ART UNIT | PAPER NUMBER |
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2137

| MAIL DATE | DELIVERY MODE |
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07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,485

Applicant(s)

KATANO, SEIICHI

Examiner

Supriya Ahuja

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This office action is responsive to Applicant's amendment received on April 23, 2007.

Claims 1-15 are pending.

2. Objection to Specification and Claims have been withdrawn due to Applicant's amendment.
3. Rejection under obviousness-type double patenting for claims 1-15 have been withdrawn because of the Terminal Disclaimer filed on April 23, 2007.
4. Rejection under 35 U.S.C. 101 for claims 1-15 have been withdrawn due to Applicant's amendment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-15** are rejected under 35 U.S.C. 103(a) as being unpatentable by Phan (US 5937150, dated 08/10/1999) in view of Walsh et al. (US 5,956,481 dated 09/21/1999) and Boldon et al. (U.S. 2003/0048468, dated 03/13/2003).

7. **As per claim 1:**

Phan discloses a multi-function peripheral device (multifunction peripheral, abstract line

1) comprising:

a network interface (SCSI interface 220, col. 3 line 6, Fig. 2) configured to allow the

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multi-function peripheral device to communicate with network devices (In step 345, the hard output unit 110a begins waiting for the control unit 110b (preferably comprises a server such as a computer having an Intel processor and running Microsoft Windows NT, col. 4 lines 1-3) to establish communication through the communications interfaces 205, 220, Fig. 2 and 3) over a network (local area network (LAN) interface, col. 1 lines 26-27); a graphical user interface (User Interface, col. 3 lines 20 – 28, Fig. 2) configured to allow for the exchange of information between the multi-function peripheral device and a user (col. 3 lines 29-34);

one or more processors (processor 260, col. 3 lines 11-12, Fig. 2);

a memory (RAM 265 and ROM 285, Fig. 2);

a scan process (scanning or scan jobs, abstract line 6, col. 4 line 16) executing in the memory (col. 4 lines 14-16) and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document (It is implicit for the scan process to scan a printed document into a digital representation, which is what a scanner does as described by www.hyperdictionary.com: An input device that takes in an optical image and digitizes it into an electronic image represented as binary data. This can be used to create a computerized version of a photo or illustration);

a print process executing in the memory (col. 4 lines 16-20) and being configured to process print data and cause a printed version of an electronic document reflected in the print data to be generated by the multi-function peripheral device at the multi-function peripheral device (It is implicit for a print process in the MFP to print an electronic

document; according to www.dictionary.com: a printer is an output device that produces a paper copy of alphanumeric or graphic data).

Phan discloses all the limitations of claim 1 except for a virus protection process.

However Walsh et al. discloses a multi-function peripheral device (computer system, see abstract line 1. The computer system is treated as a multi-function peripheral, as it may include other devices like scanner, printer, speakers, etc. (col. 8, lines 41 - 53)) comprising: a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) configured to detect that one or more unauthorized instructions (virus, abstract line 8) have been stored on the multi-function peripheral device (see abstract lines 7-8); and in response to detecting that the one or more unauthorized instructions have been stored on the multi-function peripheral device, perform one or more actions (notice offers options, col. 3 lines 59-62) to address the one or more unauthorized instructions that have been stored on the multi-function peripheral device.

However Phan and Walsh et al. does not disclose the virus scanning being taking place on the MFP.

Boldon et al. discloses a memory storing device instructions which, when processed one more processors, causes the multi-function peripheral to perform the steps of (paragraph. 0016, lines 8-12) detect that a request for data to be analyzed for viral infection has been received over a network from a network device (paragraph 0019, lines 3-7; paragraph 0016, lines 5-8); and in response to detecting receipt of the request,

providing data from the multi-function peripheral device to the network device over the network (paragraph 0016, lines 12-14).

It would have been obvious to modify Phan by substituting a virus protection process as taught by Walsh et al. and Boldon et al. in order to protect against an unauthorized loading of a virus component, such as macro code, that can result in damage to data file content and to computer storage (Walsh et al, col. 2 lines 65-67).

8. As per claims 2-7, 11 and 15:

The combination of Phan, Walsh et al. and Boldon et al. disclose all the limitations of claims 2-7, 11 and 15. See Paragraph No. 15 of the previous Office action for claims 2-7, 11 and 15

9. As per claims 8-10 and 12-14:

The combination of Phan, Walsh et al. and Boldon et al. disclose all the limitations of claims 8-10 and 12-14. See Paragraph No.11 of the previous Office action.

Response to Arguments

10. Applicant's arguments filed 04/23/2007 have been fully considered but they are not persuasive. Applicant added more features (a network interface, a graphical user interface, one or more processors, a memory, a scan process and a print process) to the claim after the amendment.

Applicants argument regarding a single multifunction peripheral device having a memory with a scan process, a print process and a virus protection process executing therein as recited in Claim 1 after the amendment is well taught by the combination of Phan, Walsh et al. and Boldon

et al. Claims 2-15 all depend from Claim 1 and therefore are unpatentable over the combination of Phan, Walsh et al. and Boldon et al.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Supriya Ahuja whose telephone number is 571-270-1588. The examiner can normally be reached on Monday - Thursday 9:30 -7:00; 2nd Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

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obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Supriya Ahuja

S.A.

June 22, 2007


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER